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EXAMINER

ROSE, SHEP K

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 08/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10 053501

Applicant(s)

Ruggles

Examiner

S. H. ROSE

Group Art Unit

1610

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above claim(s) 5 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 4, 6, 7, 10, 11, 13, 14, 17, 18, 36 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-36 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 to 4, 6 to 36, drawn to oral use aqueous compositions comprising 1(A) plural species of each of: (1) Glycyrrhizin glabra extracts, or claims 3 and 4 drawn to Markush groups of 1(A) 1 plural species of Glycyrrhiza glabra extracts; with claims to Markush groups and/or plural species of surfactants (claims 1, 6, 7, 8, 14, 15, 27, 32) plural species of divalent metal cations (claims 10, 11, 17, 18, 29, 30, 34, 35); plural species of oligosaccharides, (claims 9, 12, 16, 28, 33) as well as plural carrier vehicle species: waxy carriers, claims 19, 20, 21, 22, gel: claim 23, butter: claim 24, liquid form: claim 25, chewable, claim 31, classified in class 424, subclass 58 and 195.1.
- II. Claims 1, 2, 5 to 36, drawn to usnea spp. extract, claim 5 drawn specifically to usnic acid, classified in class 424, subclass 58 and 195.1.
- III. Claims 1 to 36, drawn to mixtures thereof, as recited in claims 1, 13, 26 and 31, classified in class 424, subclass 195.1.

Inventions I and II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are completely different extracts of completely different plant Genuses, namely I. Glycyrrhiza (licorice) and II usnea spp. (lichens), and III mixtures of I and II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and for III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Reginald Suyat on Thursday, August 1, 2002 a provisional election was made with traverse to prosecute the invention of Group I, Glycyrrhiza extract, claim 1 to 4, 6 to 36. Applicant in replying to this Office action must make affirmation of this election. Claim 5 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The restriction requirement is hereby made Final.

Applicant can file a divisional under 35 USC 121, on the non-elected invention II and III.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 to 4, 6, 7, 10, 11, 13, 14, 17, 18, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxendale et al taken with the English language abstracts of the 3 cited Japanese patents (N/O, Suido/Sunstar (I-II), and P (Nishida/Maruzen) who describe glabridin licorice extract toothpaste dentifrices (N/O) and glabridin licorice extract toothpaste dentifrices (N/O) and <sup>(p)</sup>glabridin dentifrices (as well as chewing gum, candy etc.). Baxendale et al motivate the inclusion therein of divalent metal cations (claims 10, 11) and cetylpyridinium chloride cationic surfactant (claims 6, 7).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 to 4, 6, 7, 10, 11, 36 are rejected under 35 U.S.C. 102(b) as being anticipated by each of: Baxendale et al, Ebine et al, Ishiguro et al, Yamogisti et al and Oshino et al, each describing aqueous oral use composition containers<sup>ing</sup> at least one Glycyrrhiza glabra extract recited in claim 2, with cetylpyridinium chloride recited in claim 7, and at least one divalent metal cation recited in claims 10 and 11. The copies have been marked up for applicant and his attorney's convenience with the pertinent descriptions of each ingredient noted.

Claims 1 to 36 are generic to a plurality of disclosed patentably distinct species comprising

One ultimate disclosed species of:

- (a) A G. Glabra extract from the Markush group of claim 3
- (b) a species of cationic surfactant or OT a non-ionic surfactant, from claims 7 or 8, 14, 15, 27, 32
- (c) a divalent metal cation from the Markush group of claim 11, 17, 18, 29, 30, 34, 35
- (d) a carriers vehicle selected from one of: aqueous claim 1, non-aqueous (claim 13), Buccoadhesive (claim 26) or chewable (claim 31)
- (e) a (If further elected) a waxy carrier (claims 19 to 22)
- (f) a (If further elected) a chewable polymer or rawhide, or casein, or other protein, or carbohydrate matrix of claim 31, part B
- (g) (if further elected) an oligasaccharide from the Markush group of claim 12, claim 9, claim 16, claim 28, claim 33.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, of each even though this requirement is traversed. If this application is filed under Rule 371, the legal authority is PCT Rule 13.2, Annex B, Part 1 (f) "Markush Practice"; PCT Rule 13 and 35 U.S.C. § 372, rather than 35 U.S.C. § 121.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if examiner finds one of the inventions unpatentable over the

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prior art, the evidence or admission may be used in a rejection under U.S.C. § 103 (of) the other invention.

Election of species is required per MPEP § 803, 809.02 (d) (Markush group claim practice, separate and burdensome fields of search required).

Patentably distinct Markush species are independent inventions, In re Webber, 198 USQ 328, In re Haas, 198 USPQ 334. Divisional applications may be filed under 35 U.S.C. § 121, as a result of an Office requirement for an election of a patentably distinct species as made herein. In re Joyce, 115 USPQ 412, In re Herrick, 115 USPQ 412. This satisfies the "patentably distinct" criterion since the Examiner is not of the opinion that the various species are obviously unpatentable over one another, and each species (as noted above) is capable of independent manufacture, use and sale, with the other components of the claimed formulations.

Applicant is further required to identify the claims that correspond to the elections as well as those that do not even if the requirements are traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday, Tuesday and Thursday from 7:30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



SHEP K. ROSE  
PRIMARY EXAMINER  
GROUP 1200

Rose/LR  
August 28, 2002